

Application No. 10/090,358
Amendment dated November 17, 2006
Reply to Office Action of September 1, 2006

REMARKS

Claims 1-10 are pending in the application. Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,382,441 (Svedman). Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Svedman in view of U.S. Patent No. 5,611,846 (Overton). Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Svedman in view of U.S. Patent No. 6,017,440 (Lewis). Claims 5-6 and 10 are rejected under § 103(a) as unpatentable over Svedman in view of U.S. Patent No. 6,458,109 (Henley). Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Svedman in view of Henley and in further view of U.S. Patent No. 5,855,570 (Scherson). Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Svedman in view of Henley and in further view of U.S. Patent No. 6,398,767 (Fleischmann). Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Svedman in view of Henley and in further view of U.S. Patent No. 4,955,391 (Parker).

The applicant traverses each of these rejections and respectfully requests reconsideration in view of the following remarks.

The Prior Art Does Not Teach or Suggest All of the Claimed Limitations.

Independent claim 1 is allowable because Svedman does not teach or suggest, among other things, a negative pressure therapy device that comprises "a fluid compositional sensing device." The Office Action alleges that sensor 16 of Svedman is a fluid compositional sensing device, but this is incorrect. Without specifically pointing to any supporting disclosure in Svedman, the Office Action concludes that sensor 16 is a "capacitive sensor," and that such a sensor is capable of sensing compositional characteristics of fluid. Nowhere does Svedman describe a "capacitive sensor," much less that sensor 16 is a "capacitive sensor." Nor does Svedman teach that sensor 16 is capable of sensing "compositional

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characteristics" of fluid. Rather, Svedman clearly describes sensor 16 as "arranged to sense fluid *saturation in the cell material*." Svedman, at col. 1, ll. 49-50 (emphasis added). Thus, the rejection is flawed in at least two respects. First, Svedman teaches only that sensor 16 detects a property of the cell material – not the fluid itself. Second, Svedman teaches that sensor 16 detects only the degree of fluid saturation, using principles of electrical impedance. *Id.* at col.3, ll. 50-54. Clearly, sensing fluid saturation does not encompass sensing compositional characteristics of the fluid. Without more, the Office Action does not establish that Svedman teaches or suggests this aspect of the applicant's claimed invention. Accordingly, independent claim 1 and its dependents should be allowed. Independent claim 6 and its dependents should also be allowed due to the failure of Svedman to teach or suggest, among other things, the fluid compositional sensing device. The applicant respectfully requests that the Examiner withdraw the rejection of claims 1 and 6 and their dependents under 35 U.S.C. § 102(b).

Although the applicant has pointed out specific differences between the claimed invention and the cited references that illustrate the error in the rejection, such differences are not necessarily exhaustive and the applicant reserves the right to raise additional issues as needed upon further action by the Examiner.

The Examiner Has Failed to Provide Substantial Evidence of the Alleged Motivation to Combine the Teachings of the References.

In view of the Office Action's erroneous application of Svedman, discussed above, the applicant submits that the rejection of claims 2-10 under 35 U.S.C. § 103 is moot. Additionally, however, the applicant respectfully reminds the Examiner that "identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). The Examiner may not evaluate the applicant's claims "part by part," using

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the claims as a "roadmap to find its prior art components." *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005). Most, if not all, inventions arise from a combination of old elements. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). "Thus, every element of a claimed invention may often be found in the prior art" and the Examiner must consider the claimed invention as a whole. *Id.* at 1369-70; accord MPEP § 2141.02. There must be some motivation, suggestion or teaching of the desirability of making the specific combination to establish obviousness based on a combination of the elements disclosed in the prior art. *Princeton Biochemicals*, 411 F.3d at 1337; *Kotzab*, 217 F.3d at 1370; accord MPEP § 2143.01. The teaching, suggestion, or motivation must be found either explicitly or implicitly in the references themselves, in the nature of the problem to be solved, or in the knowledge generally available to one of ordinary skill in the art. *Beckson Marine*, 292 F.3d at 728. It is the duty of the Examiner to identify the source of the motivation, and to explain why the combination of the teachings is proper. *In re Rouffet*, 149 F.3d 1350, 1356-57 (Fed. Cir. 1998); *In re Fitch*, 972 F.2d 1260, 1266 ("The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification"). Hindsight reconstruction is impermissible. *Id.*

An alleged suggestion or motivation to modify the teaching of the prior art must be supported by particular findings and substantial evidence. *Kotzab*, 217 F.3d at 1370 & 1371. Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. *Kotzab*, 217 F.3d at 1369. Broad conclusory statements of suggestion or motivation standing alone are not "evidence." *Id.* at 1370.

The Office Action merely provides broad conclusory statements regarding the alleged motivation to combine the cited references in a manner that would render obvious claims 2-10. With respect to claim 2, for example, the Office Action states only that it would be obvious to modify the

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teaching of Svedman as taught by Overton "in order to rapidly detect microorganisms/infection in the drainage fluids, as such efficiency also allows rapid treatment or alteration of a wound therapy method if needed." The Office Action does not identify the source for this alleged motivation, nor does it provide any particular findings to explain why the combination is proper. *Rouffet*, 149 F.3d at 1356-57; *Fitch*, 972 F.2d at 1266. The Examiner clearly has fallen into "the hindsight trap," *Kotzab*, 217 F.3d at 1371; *Rouffet*, 149 F.3d at 1358, and the rejection of claim 2 is improper. The Examiner's rejections of claims 3-10 also are improper for similar or analogous reasons.

Accordingly, the Office Action fails to meet the burden of a prima facie case of obviousness under § 103 and claims 2-10 should be allowed. The applicant respectfully requests that the Examiner withdraw the rejection of claims 2-10 under 35 U.S.C. § 103(a).

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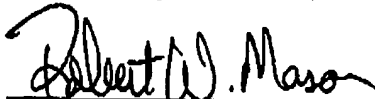
CONCLUSION

The applicant has distinctly and specifically pointed out at least one error in the Office Action, and submits that pending claims 1-10 are in condition for allowance. Accordingly, the applicant respectfully requests reconsideration of these claims and that the Examiner issue a Notice of Allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if, in the opinion of the Examiner, such a telephone conference would expedite or aid the prosecution and examination of this application.

If a Petition for Extension of Time under 37 C.F.R. 1.136(a) or an additional Petition for Extension of Time under 37 C.F.R. 1.136(a) is required, the petition is herewith made and the Commissioner is authorized to charge the required fee to deposit account number 500326.

The Commissioner is authorized to charge any fees that may be required, or credit any overpayment made with this Office Action, to Deposit Account Number 500326.

Respectfully submitted,



For Applicant

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